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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3  
4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
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7  
8 *Ex parte* ERIK D. N. MONSEN,  
9 RONALD P. SANSONE, and  
10 IAN A. SIVEYER  
11

12  
13 Appeal 2010-002873  
14 Application 10/814,328  
15 Technology Center 3600  
16

17  
18 Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and  
19 BIBHU R. MOHANTY, *Administrative Patent Judges*.  
20 FETTING, *Administrative Patent Judge*.

21 DECISION ON APPEAL<sup>1</sup>  
22

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE<sup>2</sup>

Erik D. N. Monsen, Ronald P. Sansone, and Ian A. Siveyer (Appellants) seek review under 35 U.S.C. § 134 (2002) of a final rejection of claims 1-3 and 5-21, the only claims pending in the application on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

The Appellants invented an inexpensive and time-saving method for reducing the use of gummed service stickers and the completion by hand of special forms and cards for specialty mail and certificates of mailing. Specification ¶ 004.

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added].

1. A method for providing proof of mailing one or more mail pieces by a mailer, the method comprises the steps of:
  - (a) placing an identification code on individual mail pieces with a postage meter at a location other than a post office, wherein the identification code identifies the recipient of the mail piece and uniquely identifies individual mail pieces;
  - (b) transmitting the identification code to a data center;

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<sup>2</sup> Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed December 8, 2008) and the Examiner's Answer ("Ans.," mailed March 2, 2009), and Final Rejection ("Final Rej.," mailed August 20, 2008).

- (c) depositing one or more mail pieces with the post office at the post office or at a location other than the post office;
- (d) attempting reading by the post office at a location other than the post office or at the post office the identification code that is on one or more mail pieces;
- (e) retrieving the identification code from the data center and the identification code read by the post office;
- (f) notifying the postage meter that individual identification codes have been received by the data center and individual mail pieces identification codes have been read or not read by the post office; and
- (g) printing at the postage meter a certificate indicating that the identification code has been read by the post office to provide proof of mailing the mail piece having the identification code.

The Examiner relies upon the following prior art:

Ng	US 5,174,398	Dec. 29, 1992
Montgomery	US 2003/0101147 A1	May 29, 2003

Claims 1-3 and 5-20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Montgomery.

Claim 21 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Montgomery and Ng.

### ISSUES

The issue of whether the Examiner erred in rejecting claims 1-3 and 5-20 under 35 U.S.C. § 103(a) as unpatentable over Montgomery turns on whether Montgomery describes limitations (e) and (g) of claim 1.

1 The issue of whether the Examiner erred in rejecting claim 21 under 35  
2 U.S.C. § 103(a) as unpatentable over Montgomery and Ng turns on whether  
3 Montgomery and Ng describe the service level of certified and whether a  
4 person would have found the combination of Montgomery and Ng  
5 predictable.

7 FACTS PERTINENT TO THE ISSUES

8 The following enumerated Findings of Fact (FF) are believed to be  
9 supported by a preponderance of the evidence.

10 *Facts Related to the Prior Art*

11 *Montgomery*

12 01. Montgomery is directed to personal computer based postage  
13 systems. Montgomery ¶ 0001.

14 02. Mail pieces include a self-validating unique indicium that  
15 contains data related to the mail piece such as return address,  
16 destination address, and a standard unique tracking ID.  
17 Montgomery ¶ 0080. USPS labels for administrative purpose are  
18 available for different services levels, such as Priority Mail,  
19 Express Mail, Signature Confirmation, Delivery Confirmation,  
20 First Class, and Certified Mail. Montgomery ¶ 0080. A master  
21 tracking computer system maintains tracking IDs for mail pieces  
22 and a postage-issuing computer system issues tracking IDs from a  
23 stored pool of unassigned tracking IDs downloaded from the  
24 master tracking computer system. Montgomery ¶ 0085. The

1 postage-issuing systems then transmit the assigned tracking ID to  
2 end user computers upon request. Montgomery ¶¶ 0085-0086. A  
3 communications module handles communications for transmitting  
4 tracking IDs and postage indicium requests between the master  
5 tracking computer system and other systems. Montgomery ¶  
6 0089. A tracking ID printing module prints a one-dimensional  
7 barcode that corresponds to the tracking ID received from the  
8 postage-issuing computer system and the postage indicia printing  
9 module prints a two-dimensional barcode corresponding to the  
10 self-validating unique postage indicium. Montgomery ¶ 0089.  
11 The printed labels can be affixed to the appropriate mail pieces.  
12 Montgomery ¶ 0124. A postal verifier receives the mailed mail  
13 pieces and verifies the contents of the two-dimensional barcode to  
14 validate the authenticity of the mail piece. Montgomery ¶ 0126.  
15 The system further compares the unique identifiers on the mail  
16 piece with the unique identifiers stored in the transactions  
17 database to determine whether the unique identifier on the mail  
18 piece is a duplicate of a previously received mail piece.  
19 Montgomery ¶ 0128. A database structure includes columns for  
20 date/time, account, zip code, service class, postage, weight, piece  
21 count, tracking number, and delivery status. Montgomery ¶'s  
22 0166-0167 and Table 3. Delivery statuses include submitted and  
23 delivered. Montgomery ¶'s 0166-0167 and Table 3. The status  
24 based on the tracking IDs can be obtained from the postal  
25 authority tracking system using a simple Internet transaction and a

user can see a status of delivered if the mail piece is delivered.  
Montgomery ¶ 0167.

Ng

03. Ng is directed to an improved postage scale with variable modes of operation. Ng 1:5-8. The postage scale indicates the postage amount needed. Ng 1:19-21.

04. Ng describes that typical postage scales and meters allow a user to select the type of mail service. Ng 1:15-16. The user further selects from optional services, such as registered mail, and enters a destination address. Ng 1:16-18.

## ANALYSIS

*Claims 1-3 and 5-20 rejected under 35 U.S.C. § 103(a) as unpatentable over Montgomery*

The Appellants first contend that Montgomery fails to describe or suggest limitation (e) of claim 1. App. Br. 14-16. We disagree with the Appellants. Limitation (e) requires retrieving the identification code from a data center and the identification code read by the post office. Montgomery describes a process by which mail pieces are verified for validity. FF 01-02. A unique tracking ID and unique postage indicium are assigned for a transaction and printed on to labels to be affixed to mail pieces. FF 02. Upon receipt of these mail pieces by a postal verifier, the unique tracking ID and unique postage indicium are compared to a transaction database to see if the numbers exists. Retrieving the unique tracking ID and postage indicium

1 from the transaction database is the same as retrieving this data from a data  
2 center. Retrieving the unique tracking ID and postage indicium from a  
3 postal verifier is the same as retrieving these numbers by the post office. As  
4 such, Montgomery describes limitation (e).

5 The Appellants also contend that Montgomery fails to describe or  
6 suggest limitation (g) of claim 1. App. Br. 14-16. We disagree with the  
7 Appellants. Limitation (g) requires printing a certificate that provides proof  
8 of mailing the mail piece by indicating that the identification code on the  
9 mail piece has been read by the post office. Limitation (g) further requires  
10 that this step is performed at the postage meter. Montgomery describes that  
11 the barcodes affixed to mail pieces are read by a postal verifier. FF 02. The  
12 barcodes consists of a unique tracking ID. FF 02. Montgomery further  
13 describes that the status of each mail piece is maintained and the possible  
14 statuses include submitted and delivered. FF 02. The status information is  
15 available to a user via the Internet and a user can see a status of delivered  
16 when a mail piece is delivered. FF 02. As noted by the Examiner,  
17 Montgomery fails to explicitly describe the printing of a certificate at the  
18 postage meter that provides proof of delivery. Ans. 4. However,  
19 Montgomery suggests this feature since Montgomery describes the  
20 maintenance of the delivered status of a mail piece, the communication of  
21 this status to an end user, and even further describes the printing capability  
22 of the end user. A person with ordinary skill in the art would have found it  
23 obvious to modify Montgomery's description of communicating the delivery  
24 status of a mail piece to an end user to encompass the printing of a certificate  
25 that includes the delivered status with predictable results. As such,  
26 limitation (g) is obvious in light of Montgomery.



1 The Appellants further argue that the printing of a certificate provides  
2 legal proof that the mail piece is processed; however, the limitation of “legal  
3 proof” is not recited in the claims. As such, this argument is not found to be  
4 persuasive.

5  
6 *Claim 21 rejected under 35 U.S.C. § 103(a) as unpatentable over*  
7 *Montgomery and Ng*

8 The Appellants first contend that Montgomery and Ng fail to describe  
9 obtaining from a postage meter a certificate indicating the mailer selected a  
10 service level for the mail piece to be registered mail that has been read by  
11 the Post Office. App. Br. 19. We disagree with the Appellants. As  
12 discussed *supra*, the printing of a certificate for the receipt or delivery of a  
13 mail piece is obvious in view of Montgomery. Claim 21 only further  
14 requires the limitation that the “mailer selected a service level for the mail  
15 piece to be registered mail.” Montgomery describes that several service  
16 levels that can be selected by a user and the status database includes a field  
17 for service level for each transaction. FF 02. Ng further describes the  
18 specific service level of registered mail. FF 04. As such, the combination of  
19 Montgomery and Ng describe the required limitations of claim 21.

20 The Appellants also contend that a person with ordinary skill in the art  
21 would not have been led to combine Montgomery and Ng. App. Br. 19. We  
22 disagree with the Appellants. Both Montgomery and Ng are concerned with  
23 the mailing of mail pieces and the postage costs associated with the mailing  
24 of mail pieces. FF 01 and FF 03. Montgomery addresses this concern by  
25 describing a system that validates mail pieces by a postal verifier in order to

1 ensure there is no postage fraud. FF 02. Ng solves this problem by  
2 describing a postage scale system that operates in multiple modes to provide  
3 an accurate weight to a mail piece and determines a postage amount from  
4 this weight. FF 03. A person with ordinary skill in the art would have found  
5 it obvious to modify Montgomery to include the service level of registered  
6 as described by Ng and such a modification would have been predictable  
7 because increasing the number of service levels offered increases postage  
8 options for customers and registered mail is a commonly used service level  
9 in postage systems.

#### 11 CONCLUSIONS OF LAW

12 The Examiner did not err in rejecting claims 1-3 and 5-20 under 35  
13 U.S.C. § 103(a) as unpatentable over Montgomery.

14 The Examiner did not err in rejecting claim 21 under 35 U.S.C. § 103(a)  
15 as unpatentable over Montgomery and Ng.

#### 17 DECISION

18 To summarize, our decision is as follows.

- 19 • The rejection of claims 1-3 and 5-20 under 35 U.S.C. § 103(a) as  
20 unpatentable over Montgomery is sustained.
- 21 • The rejection of claim 21 under 35 U.S.C. § 103(a) as unpatentable  
22 over Montgomery and Ng is sustained.

No time period for taking any subsequent action in connection with  
this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.  
§ 1.136(a)(1)(iv) (2007).

AFFIRMED

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